

## REMARKS/ARGUMENTS

### **Claims Status**

Claims 1, 3-10 and 12-19 are pending. Claims 1 and 10 are currently amended. Claims 2 and 11 are canceled without prejudice. Independent claims 1 and 10 are amended to include a particle size range of the surface-hydrophobated water-absorbing polymer particles pursuant to page 4, lines 6-10, of the specification. No new matter is believed to have been entered.

### **Non-Statutory Double Patenting Rejections**

Applicants respectfully request that these *provisional* rejections be held in abeyance until the present application is in condition for allowance for the following reasons. A terminal disclaimer can be filed, if the claims in the present application remain obvious in view of the claims of U.S. patent applications 10/534,753 and/or 10/137,405 at the time of allowance of the present application. Furthermore, additional amendments (if needed for allowance of these claims) may eliminate the double-patenting rejection, making the filing of a Terminal Disclaimer at this time premature. Indeed, M.P.E.P. § 804.02 IV states that, prior to issuance, it is necessary to disclaim each one of the double patenting references applied. Hence, Applicants respectfully request that the examiner contact the undersigned should the present amendments and arguments be accepted and should the present application be otherwise in condition for allowance. At that time, a terminal disclaimer if warranted can be supplied to expedite issuance of this case.

### **§102(b) and §103(a) Rejections**

The claimed invention has been rejected as follows: (i) claims 1, 2, 7-11 and 16-19 have been rejected as anticipated by Otsuka (JP-A-5-70322); (ii) claims 3-6 and 12-14 have

been rejected as obvious in view of Otsuka; (iii) claims 1-19 have been rejected as obvious in view of the combination of Masashi (AU-B-25757/95) and Otsuka. Applicants respectfully traverse these rejections.

The claimed invention relates to an emulsified cosmetic composition comprising *surface-hydrophobated* water-absorbing polymer particles and water, wherein said surface-hydrophobated water-absorbing particles have an average particle diameter of 0.1-10  $\mu\text{m}$  and comprise (a) a crosslinked polymer (see independent claim 1), or (b) a polymer or copolymer of hydrophilic vinyl monomers (see independent claim 10).

At the outset, Applicants note that the originally filed specification discusses the Otsuka reference (page 1, last line, to page 2, line 3) and states that “the surface of the water-absorbing polymer used therein is **not hydrophobated**.” Applicants further submit that this statement is due to the fact that the dimethyl polysiloxane of Otsuka does not react with a water-absorbing polymer and is therefore not hydrophobated.

Despite the specification’s assertions regarding the Otsuka reference, the Office asserts that Otsuka meets the claimed limitations because the reference discloses a hydrophobized powder obtained by subjecting one or more types of *powder* to a hydrophibization treatment ([0022]-[0023]). However, Applicants note that such a *powder* is an *additional ingredient* of the disclosed emulsified cosmetic and the types of powder include talc, kaolin, zinc oxide, titanium dioxide, mica and sericite. None of these powders disclosed by Otsuka are equivalent to the claimed polymer particles.

Accordingly, the Office’s confusion of the *powder* of Otsuka with the water-absorbing *polymer* of Otsuka has led the Office to erroneously equate the hydrophobated *powder* of Otsuka to the claimed surface-hydrophobated water-absorbing polymer particles. Thus, in line with the specification’s remarks regarding the Otsuka reference, Otsuka does not disclose *surface-hydrophobated* water-absorbing *polymer* particles.

Therefore, Otsuka does not meet all of the claimed limitations and consequently cannot anticipate the claimed invention. As such, Applicants request withdrawal of the anticipation rejections over Otsuka.

With respect to the obviousness rejections over Otsuka alone, Applicants note that not only does Otsuka fail to disclose surface-hydrophobated water-absorbing polymer particles, but Otsuka alone also fails to suggest such particles. A reference cannot provide a suggestion for that which it is silent on. As such, Applicants request withdrawal of the obviousness rejections over Otsuka alone.

Regarding the obviousness rejections in light of the combination of Otsuka and Masashi, Applicants submit that these references, alone or in combination, do not render obvious the claimed invention for at least the following reasons.

Masashi discloses “improved water-absorbent resin particles produced by treating substantially water-insoluble water-absorbent resin particles ... with an organic polysiloxane ...” (Abstract; page 5, last paragraph). While the Office recognizes that Masashi does not disclose cosmetic emulsions, antiperspirant compositions or methods of use thereof, the Office asserts that it would have been obvious to use the water-absorbing polymer particles of Masashi in the cosmetic emulsion formulations of Otsuka “because Otsuka suggests that the surface hydrophobized water absorbing polymer particles are very effective in reducing the sticky feeling observed with sweating and also imparts a long lasting effect in a cosmetic composition comprising cosmetic ingredients such as antiperspirants” (Office Action, page 10).

As can be seen from the quotation above, the Office’s asserted motivation to combine Masashi and Otsuka is based on the Office’s mistaken belief that Otsuka discloses *surface-hydrophobated* water-absorbing polymer particles. Accordingly, in light of such an

erroneous motivation to combine these two references, the Office has failed to provide a *prima facie* case of obviousness.

Notwithstanding the above, even if a *prima facie* case of obviousness did exist in light of Masashi and Otsuka, which it does not, Applicants submit that the combination of these references still fails to render obvious the claimed invention.

Applicants note that Masashi is drawn toward water-absorbing resin particles having 95 wt% or more of particles with a size of 10-1,000  $\mu\text{m}$ , preferably 50-850  $\mu\text{m}$ , and more preferably 200-600  $\mu\text{m}$  (page 8, last paragraph, to top of page 9). Moreover, Masashi explicitly states that particles having a smaller particle size tend to form lumps at the time of water absorption which undesirably deteriorates the absorption rate (Id.).

Accordingly, one skilled in the art would conclude that Masashi discloses a “preferred” working particle size of 50-850  $\mu\text{m}$ , if not even higher (200-600  $\mu\text{m}$ ). Therefore, one skilled in the art would have no motivation to look to particle sizes below 10  $\mu\text{m}$ , preferably 50  $\mu\text{m}$ , and more preferably 200  $\mu\text{m}$ . Furthermore, courts have held that where, as here, the prior art disclosure suggests the outer limits of the range of suitable values, and that the optimum resides within that range, and where there are indications elsewhere that in fact the optimum should be sought within that range, the determination of optimum values outside that range may not be obvious (*In re Sebek*, 465 F.2d 902, 175 USPQ 93, 95 (CCPA 1972)). Thus, without any motivation to consider particle sizes below 10  $\mu\text{m}$ /50  $\mu\text{m}$ /200  $\mu\text{m}$ , Applicants’ claimed average particle diameter of the surface-hydrophobated water-absorbing polymer particles of 0.1-10  $\mu\text{m}$  is not rendered obvious by Masashi. Accordingly, Applicants’ independent claims (i.e., claims 1 and 10) are not rendered obvious by Masashi.

Therefore, given the disclosure of Masashi concerning particle size and the desired particle size range of the claimed invention, one would not look to Masashi for guidance with respect to a *cosmetic emulsion*. This conclusion is further supported by Masashi’s disclosure

that particles of a smaller diameter (i.e., smaller than 10  $\mu\text{m}$ ) is not preferred (see above).

Additionally, Masashi's polymer particles are used for diapers, whereas the claimed invention is drawn toward emulsified cosmetics. Thus, one skilled in the art would have no motivation to look to large polymer particles for diapers for small polymer particles for emulsified cosmetics.

In view of the foregoing, Applicants again submit that the combination of Masashi and Otsuka fails to render obvious the claimed invention. As such, Applicants request withdrawal of the obviousness rejection in light of these two references.

### **Conclusion**

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.


Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)

  
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Justine M. Wilbur  
Attorney of Record  
Registration No. 59,678